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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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GROUP 1700

Application Number: 10/037,630
Filing Date: January 03, 2002
Appellant(s): SCOTT, J. BLAKE

J. Blake Scott
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/15/06 appealing from the Office action mailed 4/6/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 1-20 are no longer rejected over Polston (US Patent No. 6,706,108 B2).

Allowable Claims:

Claims 6, 7, 11, 12, 14, and 15 are allowable. Polston does not teach a mixture of Portland cement and class C fly ash. Further, Polston teaches that fly ash and cement are "binders" and does not give any indication that fly ash is also an aggregate

of his invention (see column 2, lines 45-46). Thus, there is no teaching in Polston to mix both fly ash (or class C fly ash for that matter) with Portland cement.

Revised Ground of Rejection to be Reviewed on Appeal:

Claims 1-5, 8-10,13, and 16-20 are rejected under 35 USC 103(a) over Polston '108 B2.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,706,108 B2	Polston	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 8-10,13, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polston '108 B2.

Polston teaches a method of making a road base by mixing drill cuttings and pozzolan, cement, fly ash, lime, or lime kiln dust (see column 2, line 46). Polston further teaches mixing an asphalt emulsifier in the binder to manufacture asphalt stabilized road base (see col.2, line 48-49). Polston would appear to differ from appellant's claimed process in that he does not teach a load bearing structure. However, one of ordinary skill in the art would have understood that a *road base* can still be construed or interpreted to mean a load bearing structure.

Further, the appellant's limitation of *said load bearing structure having sufficient resistance to rutting that any rut formed in such surface by 10,000 applications of a single axle load of 18,000 pounds will have a depth of rutting that is less than 1 inch* would have have been a property expected because the prior art mixes the same components to form a road base which is a load bearing structure.

(10) Response to Argument

The examiner has allowed claims 6,7,11,12, and 15 because Polston does not teach mixing fly ash with cement and thus these are deemed allowable. This argument presented by appellant is now moot.

The appellant next re-argues the Declaration under 37 CFR 1.132 by Mr. Dallas N. Little. Again, it is acknowledged that Mr. Little's credentials are impressive and he is most certainly an expert in this art. However this declaration is an opinon declaration of an expert in the art and while the opinion declaration is given some weight, it does not necessarily overcome the prima facie case of obviousness set forth by the examiner. Setting forth an expert analysis or opinion cannot replace or substitute experimental evidence or data supporting such opinions or positions. Appellants have so far presented no experimental evidence to bolster their opinion or position.

The appellant next states that Polston does not give any experimental data on rutting or plastic deformation resistance. In rebuttal, the examiner has set forth the case of prima facie obviousness that the same mixture of components would also result in the same properties including rutting or plastic deformation resistance. It is also noted

that the burden is upon the appellant to rebut the examiner's prima case of obviousness by means such as presenting experimental data showing his position is not correct. The appellant has presented no experimental evidence rebutting the examiner's position as stated above.

The appellant next argues page 178 of the Standard Specifications for Construction of Highways, Streets and Bridges Edition published by the Texas Department of Transportation. This document teaches particulate road base Grade 1 is not required to have more than 45 psi of compressive strength while an intermediate quality of road base may have a value of as little as 35 psi, and acceptable particulate road base has no quantitative requirement at all for compressive strength. In rebuttal, this document does not necessarily teach away from the examiner's position because it merely states that Grade 1 is "not required" to have more than 45 psi compressive strength or intermediate road base about 35 psi. This document does not state that it *cannot or must not be greater than 45 psi* for road base compressive strength. Thus, there is a degree of choice and there is no upper limit on compressive strength for road bases. It may not be required or preferred to have higher than 45 psi compressive strength for road base but this does not mean the road base compressive strength cannot be greater. Further, this road standard for road base is only directed ~~of~~ to the state of *Texas* and it could be very well be that in other states, Canada, Europe, Asia, Australia, etc. the standard for road base compressive strength may very well be higher. Appellent cannot apply the standard for one state and apply it to the entire country or

even globally because standards are not necessarily and likely not the same in other places.

The appellant has argued *reasonable expectation*. In rebuttal, the examiner has shown reasonable expectation because he mixes the same components as appellant's claimed process and the those resulting properties would have reasonably expected to be the same absent evidence to the contrary.

The appellant also notes that the examiner has offered no evidence to show this property of sufficient rutting resistance would have been the same as for their own invention. In rebuttal, the examiner has stated that Polston mixes the same components to form a road base load bearing structure that would have been expected to result in the same properties. The appellant is reminded that the burden is on him (not the examiner) to provide experimental evidence rebutting the examiner's prima facie case of obviousness. It is further noted that the examiner is not relying on common knowledge but is relying on the teaching of Polston which teaches the same components as used by applicants to make a road base (load bearing structure) and the properties resulting would have been expected to be the same.

The appellant next refers to their specification and imply that if compressive strengths are lower than 100 psi (as set forth on p.25 line 28 of appellant's specification), than by implication any product below this 100 psi value cannot be satisfactory. Appellant appears to assume what was stated on page 178 of the Standard Specifications for Construction of Highways, Streets and Bridges Edition published by the Texas Department of Transportation. This document teaches

particulate road base Grade 1 is not required to have more than 45 psi of compressive strength. Again, there is no requirement that the road base strength "must" be 45 psi or less so appellant cannot assume this in their reasoning.

The appellant refers to page 29-Table 4; page 34-Table 6; page 35-Table 9; page 38-Table 12 and their examples to show that Polston teaches away from their claims. In rebuttal, all of these examples and results are not convincing because they are not commensurate in scope with the claimed invention. Polston does not limit his invention to any specific amounts of cement or fly ash as shown by his claims 1 through 14. Further, the appellant's own claims (such as independent claims) contain no specific amounts required for their own invention (e.g. see appellant claim 1 which contains absolutely no amounts of any stabilizer component such as hydrated lime, Portland cement, cement kiln dust, etc. These results cannot be substituted for the whole teaching of Polston.

Appellant also argues that a *road base* is not a *load bearing structure* as used in their instant claims. The examiner disagrees. Even if a road base is a sublayer, its still bears the load underneath the road top layer, does it not? A road base material still is a structure that handles loads bearing upon it and thus is a load bearing structure. Appellant is also reminded that a term cannot be used when given a meaning which is repugnant to its usual meaning. In re Hill, 73 USPQ 482 (CCPA 1947). The appellant appears to be giving the term "load bearing structure" a narrow definition to include only vehicle roads or drilling pads as the only examples of "load bearing structures". The applicants are referred to lines 25-30, page 4 of their specification under BRIEF

SUMMARY OF THE INVENTION wherein they state vehicle roads and drilling pads are examples of high load bearing civil engineering structures. The appellant appears to be holding hostage their own meaning of what they consider load bearing structure by excluding any other possibilities. Certainly, other cement materials are load bearing structures and are not simply limited to roads and drilling pads. The examiner also notes that appellant is violating *in re Hill* because load bearing structures are certainly not limited to roads and drilling pads.

It is further noted that it is improper for appellant to read the limitation of a vehicle road (or drilling pad) from their specification into their independent claims for the term load bearing structure. While it is true that the claims may be read in light of the specification, it is improper to read the limitations of the specification into the claims. *In re Yamato*, 222 USPQ 93; *In re Wilson,* 149 USPQ 523; *Graver Tank v. Linde Air Products Co.* 80 USPQ 451 (Supreme Court). Appellant certainly *does not claim a road* so they cannot assume load bearing structure means only a road. A road base also bears loads even if a sublayer to the road and can still be considered a load bearing structure. If appellant means *road* only by load bearing structure, then "road" should have been in the independent claims and not load bearing structure.

The appellant also argues the next step of adding asphalt yet this is still within the teaching of Polston. Again, Polston teaches adding asphalt emulsifier in column 2, line 48.

The appellant argues overlapping ranges with respect to Polston versus their own claims. In rebuttal, Polston does teach overlapping ranges because he teaches the

same components as appellant and appellant in their own claims (see claim 1) provides no specific range of amounts and thus the same components would overlap. Polston in his own claim 1 also does not limit the addition of binder such as cement, fly ash, lime, kiln dust, or the like just like the appellant (see again col.2, line 46).

Appellant's argument regarding claims 7,11, 12, 14, and 15 are moot because appellant is correct in that Polston does not teach a mixture or combination of fly ash and cement. Note that fly ash is inclusive of both class F and class C fly ash depending where the source of fly ash is obtained (Wyoming for example for Class C and West Virginia for example for Class F). Still, Polston does not teach mixing together fly ash an cement (e.g. Portland cement) and thus these claims are allowable.

The appellant states the examiner did not address Claims 13 and 15-20 regarding limitations such as an unconfined compressive strength of at least 100 psi and various thicknesses. In rebuttal, as stated above:

Page 178 of the Standard Specifications for Construction of Highways, Streets and Bridges Edition published by the Texas Department of Transportation. This document teaches particulate road base Grade 1 is not required to have more than 45 psi of compressive strength while an intermediate quality of road base may have a value of as little as 35 psi, and acceptable particulate road base has no quantitative requirement at all for compressive strength. In rebuttal, this document does not necessarily teach away from the examiner's position because it merely states that Grade 1 is "not required" to have more than 45 psi compressive strength or intermediate road base about 35 psi. This document does not state that it *cannot or must not be greater than 45 psi* for road base compressive strength. Thus, there is a degree of choice and there is no upper limit on compressive strength for road bases. It may not be required or preferred to have higher than 45 psi compressive strength for road base but this does not mean the road base compressive strength cannot be greater.

It is thus possible by appellant's own admission based upon this standard specification submitted evidence from the Texas Highway Department of transportation

that road base 1 is not required to have more than 45 psi of compressive strength. Not required does not mean it must have no more than 45 psi of compressive strength which leads open to the possibilities that a road base can even have a compressive strength as high or greater than 100 psi and thus meet the limitations of claims 13 and 16-20. (Note again that claim 15 is allowable because it depends back to claim 6 which requires a mixture of class C fly ash and Portland cement and thus any arguments toward this claim are now moot).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Paul Marcantoni
Primary Examiner
Art Unit 1755

Conferees:

Jerry Lorengo
SPE Art Unit 1755

Patrick Ryan
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